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AUG 22 2003

OFFICE OF PETITIONS

In re Application of: :
Claycomb, et al. :
Filed: 25 January, 1995 :
Application No. 09/470,116 :
Docket No.: 11016.02 :

ON PETITION

This is a decision on the petition filed herein on 29 July, 2003, alternatively under 37 C.F.R. §1.137(a)¹ (as to unavoidable delay) and §1.137(b)² (as to unintentional delay) to revive the above-identified application, and in light of the allegations and express request considered as a

¹ A Petition filed under the provisions of 37 C.F.R. §1.137(a) must be accompanied by:

- (1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application for patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;
- (2) the petition fee required by 37 C.F.R. §1.17(l);
- (3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the reply due date until the filing of a grantable petition pursuant to the is paragraph was unavoidable; and
- (4) Any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c).

An application is "unavoidably" abandoned only where Petitioner (or Petitioner's counsel) takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, the response is not timely received in the Office. That is, in the context of ordinary human affairs the test is such care as is generally used and observed by prudent and careful persons in relation to their most important business. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r. Pat. 1913).

² Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). a grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:

- (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.
- (2) the petition fee as set forth in 37 C.F.R. §1.17(m);
- (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and
- (4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

petition to withdraw the holding of abandonment under 37 C.F.R. §1.181.³

For the reasons set forth below, the petition:

- the petition as considered under 37 C.F.R. §1.181 to withdraw the holding of abandonment is **DISMISSED**; and
- under 37 C.F.R. §1.137(a) is **DISMISSED**.
- under 37 C.F.R. §1.137(b) is **DISMISSED**.

NOTES:

- (1) Any petition (and fee) for reconsideration of this decision under 37 C.F.R. §1.137(a) (as to unavoidable delay) or an alternative request for relief under 37 C.F.R. §1.137(b)⁴ (as to unintentional delay) must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(a)"; and/or "Petition under 37

³ The regulations at 37 C.F.R. §1.181 provide, in pertinent part:
§1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. * * *

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Brief or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declaration (and exhibits, if any) must accompany the petition.

© When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, it may be required that there have been a proper request for reconsideration (§1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed. * * *

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings. * * *

⁴ Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). a grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 C.F.R. §1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

C.F.R. §1.137(b)";

- (2) Thereafter, there will be no further reconsideration of this matter.

BACKGROUND

The record indicates that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 8 November, 2001, and due (absent extension of time) on or before Friday, 8 February, 2002;
- the application was deemed abandoned after midnight 8 February, 2002;
- Petitioner Paul J. Prendergast (Reg. No. 25,364) and former associate Robert J. Scheffel (Reg. No. 43,090) detail that:

--following Mr. Scheffel's 24 January, 2002, telephone conference with the Examiner regarding Petitioner's amendment filed on 24 August, 2001, and the non-final Office action of 8 November, 2001, the "Interview Summary" (transmitted via FAX on 25 January, 2002, and then mailed on 27 August, 2002) indicated that the Examiner would have to perform a further search; and

--Petitioner and Mr. Scheffel interpreted that to mean that they had to make no further response to the 8 November, 2001, non-final Office action;

- Mr. Scheffel also indicates that he left the employ of Petitioner's office in July 2002 to commence a judicial clerkship;
- the Interview Summary indicates that:

--"Agreement with respect to the claims * * * g)x was not reached" (emphasis supplied); and

--the Examiner stated: "Discussed the differences and similarities between the claimed invention and the prior art reference. A search will be needed based on the discussion[,] however, there is no indication that the Examiner withdrew or otherwise modified the Office action, and so relieved Petitioner of the timely response

requirement under statute;

- Notice of Abandonment was mailed on 12 February, 2003;
- it does not appear that a Status Inquiry was filed regarding this matter between the date of abandonment (8 February, 2002) and the mailing of the Notice of Abandonment (12 February, 2003);
- as of this writing, Petitioner has failed to file a written reply to the 8 November, 2001, non-final Office action.⁵

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).⁶

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.⁷

Delays in responding properly raise the question whether delays are unavoidable.⁸ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing

⁵ On Wednesday, 13 August, 2003, a call was placed by the Office of Petitions to Petitioner regarding this failure to file a reply, and when Petitioner did not answer his line a message was left with his office. As of this writing (Thursday, 14 August, 2003, Petitioner has not responded to that call.

⁶ 35 U.S.C. §133 provides:
35 U.S.C. §133 Time for prosecuting application.
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁷ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁸ See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁹ And the Petitioner must be diligent in attending to the matter.¹⁰ Failure to show diligence does not constitute the care required under Pratt.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.¹¹))

Allegations as to the Request to Withdraw
the Holding of Abandonment and
the Petition Alleging Unavoidable Delay

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.¹²

Petitioner has failed to evidence that the Office improperly deemed the instant application abandoned (e.g., that Petitioner did not receive the 8 November, 2001, Office action or Petitioner filed and the Office received a reply to that Office action), and thus fails to satisfy the requirements for having the holding of abandonment withdrawn.

A delay is not "unavoidable" when an applicant simply fails to file properly and timely the required reply and so permits the maximum extendable statutory period for reply to expire.¹³

In determining if a delay was unavoidable, decisions on reviving abandoned applications have adopted the standard of the reasonably prudent person acting in their most important business matters.¹⁴

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and

⁹ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

¹⁰ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

¹¹ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

¹² See: Delgar v. Schulver, 172 USPQ 513 (D.D.C. 1971).

¹³ See MPEP 711.03(c)(III)(C)(2).

¹⁴ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

circumstances into account."¹⁵

Petitioner was informed in the 8 November, 2001, Office action that the then-pending claims had been rejected.

Apparently Mr. Scheffel sought and obtained a telephone conference with the Examiner, and, as a result of the telephone conference on 24 January, 2002, the Examiner expressly told Petitioner (via the Interview Summary) that, Mr. Scheffel and the Examiner "[d]iscussed the differences and similarities between the claimed invention and the prior art reference. A search will be needed based on the discussion." However, despite the discussion, "[a]greement with respect to the claims * * * was not reached."

In short, there is no indication that the Examiner withdrew or otherwise modified the Office action of 8 November, 2001.

At that point in time Petitioner had two weeks remaining in the shorted statutory period and could have requested and obtained up to three (3) months in extensions of time to reply within the statutory maximum.

Moreover, the Interview Summary form itself contains an excerpt of the controlling regulations at 37 C.F.R. §1.133,¹⁶ which provide that: "[a]n interview does not remove the necessity for reply to Office action as specified in §§1.111 and 1.135 (35 U.S.C. §132)."

Nonetheless, Petitioner simply failed to file a timely and proper response to the final Office action--and then allowed both the shortened statutory period and the statutory maximum period to expire.

Such practice clearly does not satisfy the Pratt requirements of diligence in attending to one's most important business affairs.

¹⁵ Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

¹⁶ The regulations at 37 C.F.R. §1.133 provide:

§1.133 Interviews.

(a)(1) Interviews with examiners concerning applications and other matters pending before the Office must be conducted on Office premises and within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director.

(2) An interview for the discussion of the patentability of a pending application will not occur before the first Office action, unless the application is a continuing or substitute application.

(3) The examiner may require that an interview be scheduled in advance.

(b) In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office actions as specified in §§1.111 and 1.135.

[Para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(1) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

Therefore, Petitioner fails to satisfy the showing as required under 37 C.F.R. §1.137(a).

Presuming for the purposes of discussion that it was an act/omission of Counsel that contributed to any of the delay herein, the act(s) or omissions of the attorney/agent are imputed wholly to the applicant/client¹⁷ in the absence of evidence that the attorney/agent has acted to deceive the client.¹⁸

(It long has been the position of the Office that the use of the filing periods (such as in 37 C.F.R. §1.137(b)) as an "extension of time" is an "abuse" of the procedures for reviving abandoned applications, and is contrary to the meaning and intent of the regulation.¹⁹ The Office has indicated that petitions to revive must be filed promptly after the applicant becomes aware of the abandonment.²⁰ Such delays are inconsistent with a showing of diligence in the prosecution of one's application,²¹ and such a course of action would preclude revival of an application under 37 C.F.R. §1.137.²²)

Accordingly, Petitioner has failed to establish to the satisfaction of the Commissioner that the delay was "unavoidable" within the meaning of 37 C.F.R. §1.137.²³

¹⁷ The actions or inactions of the attorney/agent must be imputed to the petitioners, who hired the attorney/agent to represent them. Link v. Wabash Railroad Co., 370 U.S. 626, 633-634, 82 S.Ct. 1386, 1390-91 (1962).

The failure of a party's attorney to take a required action or to notify the party of its rights does not create an extraordinary situation. Moreover, the neglect of a party's attorney is imputed to that party and the party is bound by the consequences. See Huston v. Ladner, 973 F.2d 1564, 23 USPQ2d 1910 (Fed Cir. 1992); Herman Rosenberg and Parker-Kalon Corp. v. Carr Fastener Co., 10 USPQ 106 (2d Cir. 1931).

¹⁸ When an attorney intentionally conceals a mistake he has made, thus depriving the client of a viable opportunity to cure the consequences of the attorney's error, the situation is not governed by the stated rule in Link for charging the attorney's mistake to his client. In re Lonardo, 17 USPQ2d 1455 (Comm'r. Pat. 1990).

¹⁹ See: In re Application of S., 8 USPQ2d 1630, 1632 (Comm'r Pats. 1988). Where there is a question whether the delay was unintentional, the petitioner must meet a burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 C.F.R. §1.137(b). See: In re Application of G., 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

²⁰ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

²¹ The test of diligence in the prosecution of an application before the Commissioner is, in the context of ordinary human affairs, the test is such care as is generally used and observed by prudent and careful persons in relation to their most important business. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r. Pat. 1913).

²² That an applicant may have been preoccupied with other matters that took precedence over the revival of an abandoned application is not viewed as an adequate justification for delay. See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Rather, the revival of an application that was not intentionally abandoned is the applicant's "most important business." See Ex parte Pratt, 1887 Dec. Comm'r Pats. 31, 32-33 (1887). Specifically, an applicant seeking revival of an abandoned application is expected to file a petition under 37 C.F.R. §1.137 within two to three months of discovering its abandonment. See In re Kokaji, 1 USPQ2d 2005, 2007 (Comm'r Pats. 1986); see also Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53161, 1203 Off. Gaz. Pat. Office at 88-89 (response to comment 65).

²³ See Application of G., 11 USPQ2d at 1380; In re Application of S., *Id.*

Allegations as to the Petition
Alleging Unintentional Delay

Petitioner has filed the petition (with fee authorization).

However, as of this writing Petitioner has not made the statement of unintentional delay and filed a reply to the 8 November, 2001, Office action. Thus, Petitioner has not satisfied the “reply” and “statement” requirements of the regulation.

CONCLUSION

Because Petitioner failed to satisfy the burdens set forth in Delgar v. Schulyer, the petition under 37 C.F.R. §1.181 must be and hereby is **dismissed**.

Moreover, the circumstances of this application do not demonstrate as of this writing that the delay in filing the first petition was/is within the statutory and regulatory meaning of unavoidable delay--and the instant petition fails to satisfy the “showing” and the “reply” requirements as to relief sought.

In the absence of those requirements, the petition herein under 37 C.F.R. §1.137(a) must be and hereby is **dismissed**.

Finally, the circumstances of this application do not demonstrate as of this writing that Petitioner has satisfied “reply” and “statement” requirement as to relief sought.

In the absence of those requirements The petition herein 37 C.F.R. §1.137(b) must be and hereby is **dismissed**.

Further correspondence with respect to this matter should be addressed as follows:

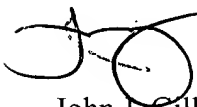
By mail: (Effective 1 May, 2003)²⁴
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 308-6916
ATTN.: Office of Petitions

²⁴ To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.

By hand: Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.

A handwritten signature in black ink, appearing to be 'J. Gillon', with a large circular flourish at the end.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions